

## **Remarks/Arguments**

### **A. Status of the Claims**

Claims 19-21, 25, 27-32, 38-39, and 44 are revised, support for which can be found throughout the specification and claims as originally filed (*see, e.g.*, specification at page 5, lines 22-25).

Claims 19-44 are pending, with claims 23-24, and 29 currently withdrawn from consideration.

### **B. Species Election and Restriction Requirements**

Applicant requests that claims 23-24 and 44 be rejoined. The arguments presented in the following sections confirm that the (1) elected species is allowable and (2) claims 19 and 44 share a special technical feature—mainly, an optical lens having the claimed temporary protective layer covering the surface of the lens in an amount sufficient to provide adhesion of the lens to a holding pad during edging of the lens and a peelable coating, which functions to protect the temporary coating. This is explained in further detail in Sections E and F below.

### **C. Information Disclosure Statement**

Applicant agrees with the Examiner that references A19, A25, A26, A29, and C5 are not material to the patentability of the subject matter of the claimed invention. These references, along with C3, were inadvertently submitted in the previous SIDS, for which Applicant apologizes. Also, previously submitted reference A10 is the English equivalent of Reference B13.

**D. Claim Objections and Indefiniteness Rejections**

Claim 39 is revised per the Examiner's suggestion.

Claim 19 is revised to address the Examiner's concerns. For instance, the optical lens is coated with a temporary coating. The temporary coating by itself includes an outermost layer. The outermost layer of the temporary coating is coated with a peelable film. That is, the temporary layer is not claimed as being the external layer of the entire stack deposited on the lens. The order of the layers in claim 19 are clear: lens/temporary coating/peelable film (note that additional layers can be included between the lens and temporary coating). The specification supports this interpretation. *See* MPEP 2173.02 ("Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.").

Applicant requests that the claim objections and indefiniteness rejections be withdrawn.

**E. The Claimed Invention Is Novel Over Ohlin**

Claims 19, 20, and 33-36 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent 5,792,537 ("Ohlin").

Applicant respectfully disagrees. In order to support the anticipation rejection, every element of the rejected claims must be "identically shown" in this reference. *See In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990) ("For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference."). This standard is not met with respect to present claim 19 (and its corresponding dependent claims) *vis-à-vis* the disclosure made in Ohlin.

For instance, the temporary protective layer in claim 19 "covers the surface of the lens in an amount sufficient to provide adhesion of the lens to a holding pad during edging of the lens."

By comparison, the removable ink markings in Ohlin do not cover a sufficient surface area of the lens to obtain satisfactory adhesion of its lens to a holding pad, much less during a trimming process. This is illustrated in Figure 1 of Ohlin, where a person of ordinary skill in that would recognize that the position of the markings at the surface of the lens is not suitable to obtain the requisite adhesion during trimming. This is also confirmed by the edging process described in Ohlin, which requires the use of an adhesive tape "20" to bind the lens blank to an alloy block, which subsequently allows for edging of the lens (col. 5, lines 33-59). That is, the adhesive tape "20" is required to edge the lens in Ohlin(*Id.*; *see also* col. 3, lines 31-34).

The current anticipation rejection should be withdrawn, as Ohlin fails to disclose every element of the claimed invention. *See In re Bond*, 910 F.2d at 832.

**F. The Claimed Invention Is Patentable Over Conte + Ohlin**

Claims 19-22, 25-36, and 38-43 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over the combination of WO 03/057641 ("Conte") in view of Ohlin.

Applicant disagrees with this rejection. A *KSR* based analysis confirms that there is no apparent reason to place the mask described in Ohlin over the ink marking disclosed in Conte, as alleged by the Examiner at page 6 of the Action.

***The pertinent issue underlying the obviousness rejection:*** A difference between Conte and Applicant's claimed invention is the presence of a peelable film electrostatically adhering to the outermost layer of the temporary protective coating, the effect of which being to avoid a degradation of said protective coating during storage and transportation of the lenses. The objective technical problem underlying the claimed invention can be formulated as avoiding degradation of a temporary coating (which consequently is rather susceptible to degradation) during storage and transportation of the lenses (see Specification at page 2, line 20, to page 3,

line 3). The solution to this problem is the coverage of said temporary coating with a peelable film electrostatically adhering to it, as demonstrated by examples 1 and 2 of the Specification. Thus, the question to be answered is whether there is any teaching in the cited art as a whole that would (not simply could) have prompted the skilled person, faced with the objective technical problem, to modify or adapt the lens of Conte while taking account of that teaching, thereby arriving at the claimed invention. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41 (2007) (explaining the importance of identifying “an apparent reason to combine the known elements in the fashion claimed by the [application] at issue.”).

***Scope and Content of Conte:*** Conte discloses an ophthalmic lens having a temporary protective layer, the purpose of which is to temporarily protect an underlying hydrophobic and/or oleophobic layer (page 6, lines 9-19). The temporary coating can also include ink marks that are used as reference points to ensure proper mounting of the lens in the corresponding lens frame (page 11, lines 10-12). As noted by the Examiner, this reference does not disclose application of a peelable film on the Conte temporary protective layer.

***Scope and Content of Ohlin:*** A peelable film (mask) is employed in Ohlin solely for protecting a marking ink during the edging operation. The electrostatic film, which is interleaved between the ink and the adhesive tape (see Figures 3-4), prevents the adhesive surface of the tape (which is used during the edging operation and which covers the entire surface of the lens) to be in contact with the marking ink. The following provides an illustration of Ohlin's disclosure *vis-à-vis* the claimed invention:

Adhesive tape	
Mask	Electrostatic peelable film
Removable marking ink	Temporary coating
Lens	Lens

Ohlin                      The claimed invention

***Difference Between Cited Art and Claimed Invention Are Not Obvious Differences:***

Starting from Conte, there was no incentive to deposit an electrostatic peelable film onto a temporary layer so as to obtain a lens according to the invention as claimed. Stated another way, there is no apparent reason to use Ohlin's peelable film/mask to protect the Conte temporary coating that is temporary to begin with—why protect a temporary coating with another temporary coating? The end result of the Examiner's proposed combination of Ohlin's mask with the Conte temporary protective coating is redundancy—to protect a temporary layer with another temporary layer. Conte provides data showing that only one temporary layer is needed—*i.e.*, there is no need or suggestion to protect the Conte temporary layer with a peelable film such as Ohlin's mask.

The fact that the temporary coating described in Conte can also be marked with an ink (page 11, lines 10-12) does not supply the requisite "apparent reason" to place the Ohlin peelable mask on the Conte temporary coating. Applicant respectfully notes that the Examiner's rationale at page 6 of the Action to make such a combination—"It would be obvious to one of ordinary skill in the art to use the mask of Ohlin, over the ink markings of Conte, in order to ensure that the marking are protected from removal during subsequent processing"—fails to consider the full teachings of both references. In this regard, Applicant submits that Ohlin, when considered in its entirety, explains that its mask is used during the trimming process to prevent contact between

the ink and adhesive tape (col. 3, lines 26-36). The process is based on the formation of a block on the adhesive tape to obtain sufficient means to hold the lens to a lens holding apparatus (col. 5, lines 40-59). The Ohlin mask is not removed until after the trimming process is completed (col. 5, line 60, to col. 6, line 16).

By comparison, Conte describes and utilizes a trimming process which is far removed from the block method described in Ohlin. For instance, the Conte trimming process does not utilize a mounting block nor an adhesive tape which, according to Conte, can destroy the ink markings used for mounting the lens. Rather, it uses a temporary protective layer which provides sufficient adhesion between the lens and a lens holding apparatus. *See* Conte at page 8, lines 29-36.

While keeping the above in mind, Applicant fails to see an “apparent reason” *ala* KSR to place the Ohlin mask onto the Conte protective layer for at least the following reasons:

- The Conte trimming process does not use or require an adhesive tape which could, according to Ohlin, remove ink markings. Therefore, the apparent reason to use the Ohlin mask, as explained by Ohlin, in the Conte trimming process is simply not present.
- Ohlin explains that its mask is required during the trimming process. Therefore, a person of ordinary skill, upon reading Ohlin, would be lead to incorporate the mask into a trimming process. By comparison, such a mask is not needed in the Conte trimming process. If anything, use of the Ohlin mask during the Conte trimming process would change the way the Conte trimming process works—*i.e.*, it would basically render the temporary coating useless if covered by a mask during trimming. Further, the presence of the Ohlin mask on the Conte lens would destroy the needed adhesion of the Conte lens with a corresponding holding apparatus—the very purpose of the Conte temporary layer would be destroyed/rendered moot. These types of facts provide convincing evidence that there is no apparent reason to combine Conte with Ohlin. *See* MPEP § 2143.01(VI) (“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”).

- The problem addressed in Ohlin was the removal of ink markings by adhesive tape in block trimming methods—the solution being the Ohlin mask. By comparison, one of the problems addressed in Conte was lack of sufficient adhesion of a hydrophobic/oleophobic coated lens to a lens holding apparatus—the solution being a temporary layer which can provide sufficient adhesion of the lens to the holding apparatus. The reality of Ohlin and Conte is that they (1) concern completely different trimming processes and (2) different problems associated with trimming ophthalmic lens.

In view of these acute differences, the Examiner's argument that a person of ordinary skill would place the Ohlin mask onto the Conte temporary coating to protect ink markings made on the coating respectfully appears to be grounded on the use of improper hindsight. That is to say, neither Ohlin nor Conte explain a need to protect the Conte temporary coating (or ink marking on such a coating). The need to protect the ink markings in Ohlin is derived from the fact that such markings are removed when an adhesive tape (a required element in the Ohlin trimming method) is removed. Further, the ink markings in Ohlin are made directly on the lens, which necessarily means that they have to be removed; that is, the Ohlin ink markings are susceptible to removal during the trimming process and therefore need to be protected, hence the mask.

The same need, based on the art of record, does not exist with the Conte ink markings, as the Conte process does not utilize an adhesive tape. Further, the ink markings in Conte are made on the temporary layer which is intended to directly interface with the holding apparatus. That is, there is no need to protect the ink markings in Conte because the Conte lens/temporary layer/ink markings are made with the intention that they directly contact the holding apparatus—any other interpretation would be contrary to the disclosures made in Conte.

Further, both Ohlin and Conte are not concerned with the problem of protecting a temporary layer during transportation and/or storage of lenses. Nothing in these references, taken alone or in combination, could prompt those skilled in the art to think that placing an electrostatic peelable film on an outer protective layer of an optical lens would sufficiently protect the temporary protective coating from a mechanical degradation during transportation and/or storage.

The peelable electrostatic film of Ohlin and that of the present invention fulfill completely different functions, and nothing suggests that the peelable film of Ohlin could be used (or is even needed) for another application—much less Applicant's claimed application. Once the edging step is over, the film is immediately removed in Ohlin, simultaneously with the adhesive tape to which it is bonded (col. 6, lines 4-7). It is not maintained on the lens during transportation and storage of the lenses.

The logical conclusion is that the Examiner respectfully appears to have found an apparent reason to make the Conte/Ohlin combination based on Applicant's own disclosure. This is an improper use of hindsight reconstruction. When Conte and

Ohlin are considered without the benefit of Applicant's specification, the need to protect the ink markings on the Conte temporary layer simply does not exist (see above).

Further, Applicant respectfully notes that the ink markings referenced by the Examiner in both Conte and Ohlin are used as guidance means to ensure proper mounting of the lens into the corresponding lens frame. *See* Ohlin at col. 2, lines 10-32. There is no suggestion in any of these references that such ink markings are used to provide sufficient adhesion of the lens to a holding apparatus during trimming. In this regard, Ohlin states:

...it is necessary to provide visual markings on the lens blank so that the laboratory technician knows how the lens is to be mounted in the frame and so that the lens is properly oriented when the lens is sized and shaped to fit into the frame after it has been ground to a prescription. [col. 2, lines 10-15]

...the lens blanks are marked with visible ink indicia by the manufacturer to allow proper alignment of the lens. [col. 2, lines 32-34]

The reality is that the amount of ink used for these ink markings in both Conte and Ohlin are **insufficient** to provide adhesion of the lens to a holding pad during edging of the lens.

**Conclusion:** For at least the reasons discussed above, Applicant requests that the present obviousness rejection be withdrawn.

**G. The Claimed Invention Is Patentable Over Ohlin + Mascarenhas**

Dependent claim 37 is rejected under 35 U.S.C. § 103(a) as allegedly being obvious over the combination of Ohlin in view of U.S. Patent 5,888,615 ("Mascarenhas").

This rejection fails for the same reasons discussed in the above sections. For instance, Ohlin fails to disclose or suggest a temporary protective layer in claim 19 which "covers the surface of the lens in an amount sufficient to provide adhesion of the lens to a holding pad during edging of the lens." Mascarenhas does not supplement this deficiency.

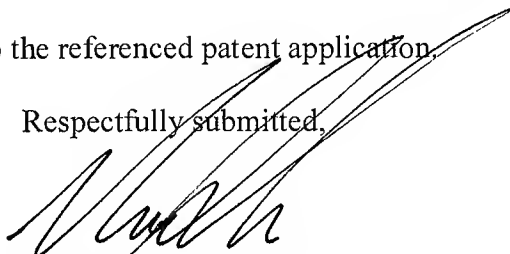


Therefore, the obviousness rejection should be withdrawn, as every element is not disclosed or suggested by the combination of cited references. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (“obviousness requires a suggestion of all limitations in a claim”) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

#### **H. Conclusion**

Applicant believes that this case is in condition for allowance and such favorable action is requested. The Examiner is invited to contact the undersigned Attorney at 512.536.3020 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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